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7 UNITED STATES DISTRICT COURT
8 FOR THE WESTERN DISTRICT OF WASHINGTON
9 AT SEATTLE

10 NEW ISLAND CAPITAL MANAGEMENT,
11 INC.,

12 Plaintiff,

13 v.

14 WWW.NEWISLANDCAPITAL.COM,

15 Defendant.
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Case No.

**PLAINTIFF NEW ISLAND CAPITAL
MANAGEMENT, INC.'S *IN REM*
COMPLAINT AGAINST THE
WWW.NEWISLANDCAPITAL.COM
DOMAIN NAME TO TRANSFER THE
DOMAIN NAME TO PLAINTIFF UNDER
15 U.S.C. § 1125(d)**

JURY TRIAL DEMANDED

COMPLAINT

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SEATTLE, WASHINGTON 98101
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1 Plaintiff New Island Capital Management, Inc. ("Plaintiff") alleges the following in
 2 support of its *in rem* complaint against the Internet Domain Name
 3 www.newislandcapital.com.

4 **I. NATURE OF THE ACTION**

5 1. Plaintiff files this *in rem* action asserting a claim of cyberpiracy under the
 6 Anticybersquatting Consumer Protection Act ("ACPA"), 15 U.S.C. § 1125 et seq.

7 2. This lawsuit involves quintessential cyberpiracy. Plaintiff owns the NEW
 8 ISLAND CAPITAL trademark and has registered that trademark in the United States, Canada
 9 and the European Union. On information and belief, with knowledge of Plaintiff's ownership
 10 of the NEW ISLAND CAPITAL trademark, the registrants ("Registrants") of
 11 www.newislandcapital.com registered the domain name in bad faith, are using the domain
 12 name in bad faith, and are willfully intercepting confidential email messages intended for
 13 Plaintiff.

14 3. This is the precise scenario that the ACPA was enacted to combat – to prevent
 15 cyberpirates from registering domain names incorporating distinctive trademarks and then
 16 using that domain name in bad faith to the detriment of the trademark holder.

17 4. In bringing this lawsuit, Plaintiff seeks an injunction prohibiting the
 18 Registrants' use of the www.newislandcapital.com domain name and ordering the domain
 19 registrar, eNom, Inc. ("eNom") to transfer the www.newislandcapital.com domain name to
 20 Plaintiff.

21 **II. JURISDICTION AND VENUE**

22 5. This Court has subject matter jurisdiction over this claim pursuant to 28 U.S.C.
 23 §§1331 and 1338(a).

24 6. This Court has *in rem* jurisdiction over the domain name pursuant to 15 U.S.C.
 25 § 1125(d)(2)(A)(ii)(1) since Plaintiff cannot obtain *in personam* jurisdiction over the
 26 Registrants of www.newislandcapital.com because the Registrants are located outside of the

United States. *In rem* jurisdiction is proper in this district pursuant to 15 U.S.C. §1125(d)(2)(C)(i) because the domain name registrar, eNom, is located in this district at 5808 Lake Washington Blvd. NE, Suite 300, Kirkland, Washington 98033.

7. Venue is proper in this district under 15 U.S.C. §1125(d)(2)(A) & (C) because eNom is the registrar of www.newislandcapital.com and eNom is located in this district. Attached hereto as Exhibit A is a true and correct copy of the WHOIS record for www.newislandcapital.com, showing eNom as the registrar.

III. THE PARTIES

8. Plaintiff New Island Capital Management, Inc. is a Delaware corporation with its principal place of business at 505 Sansome Street, Suite 1450, San Francisco, California, 94111. Plaintiff is a 100% mission-focused investment advisor striving to achieve positive impact within four thematic areas: Sustainable Agriculture, Communities, Alternative Energy and Environment. Its mandate places it among a handful of institutional-scale, mission-focused investment advisors.

9. On information and belief, and according to the website currently located at www.newislandcapital.com, the defendant domain name is registered by individuals located in Asia. The Registrants of www.newislandcapital.com, however, use “WhoisGuard” which hides the Registrants’ true identity from the public. Moreover, despite Plaintiff’s diligent efforts, Registrants have prevented Plaintiff from uncovering Registrants identity by operating anonymously.

IV. FACTUAL BACKGROUND

A. Plaintiff’s Trademark Rights

10. Plaintiff is the owner of United States Trademark Registration Number 3463051, for the trademark NEW ISLAND CAPITAL. Plaintiff has used the trademark NEW ISLAND CAPITAL in connection with Plaintiff’s services, including financial services, such as, advising and management of private equity investment funds. Plaintiff has

1 priority in the NEW ISLAND CAPITAL trademark since at least December 5, 2006.
2 Plaintiff's registration is valid, unrevoked, subsisting, and constitutes *prima facie* evidence of
3 Plaintiff's exclusive ownership of the NEW ISLAND CAPITAL mark. Attached hereto as
4 Exhibit B is a true and correct copy of Plaintiff's registration certificate for the NEW
5 ISLAND CAPITAL trademark. Plaintiff also has obtained registrations of the NEW ISLAND
6 CAPITAL mark in Canada and in the European Union.

7 11. Plaintiff has invested significant time and money in developing and promoting
8 its trademark and brand, including use on its website, at events and trade shows, recruiting
9 and networking. As a result of such use and expenditures, Plaintiff has established
10 considerable goodwill in the NEW ISLAND CAPITAL trademark. The NEW ISLAND
11 CAPITAL trademark and its associated goodwill are valuable assets of substantial worth to
12 Plaintiff.

13 **B. Cyberpiracy of www.newislandcapital.com**

14 12. The www.newislandcapital.com domain was registered in bad faith and is
15 being used in bad faith under the ACPA. Bad faith intent may be shown under the ACPA by
16 proof that: (1) the registrant registered the domain name consisting of the legal name of the
17 Plaintiff; (2) the registrant failed to use the domain name in connection with a bona fide
18 offering of goods or services; (3) the registrant intended to divert consumers from the mark
19 owner's online location to a site accessible under the domain name; or (4) the registrant's
20 registration of multiple domain names which the registrant knows are identical or confusingly
21 similar to the marks of others. *See* 15 U.S.C. §1125(d)(1)(B).

22 13. The Registrants of www.newislandcapital.com have exhibited each of these
23 forms of bad faith. For example, the www.newislandcapital.com domain name wholly
24 incorporates Plaintiff's NEW ISLAND CAPITAL trademark. On information and belief, the
25 Registrants were aware of Plaintiff's NEW ISLAND CAPITAL trademark when they
26 registered the www.newislandcapital.com domain name in December 2010 – more than two

1 years after the United States Patent and Trademark Office issued Plaintiff's registration for
 2 the NEW ISLAND CAPITAL trademark. The Registrants are not authorized by Plaintiff to
 3 use the NEW ISLAND CAPITAL trademark.

4 14. On information and belief, the Registrants are not offering any bona fide goods
 5 or service in connection with its use of www.newislandcapital.com. Instead, they are using
 6 www.newislandcapital.com for the purpose of obstructing Plaintiff's use of its trademark and
 7 defaming Plaintiff.

8 15. The Registrants are wrongly benefiting from their bad faith use of Plaintiff's
 9 NEW ISLAND CAPITAL trademark as they are diverting consumers from Plaintiff's website
 10 to the pirated www.newislandcapital.com domain name. The Registrants have further
 11 received and continue to receive confidential email messages intended for Plaintiff.

12 16. Finally, on information and belief, the Registrants have registered numerous
 13 domain names which are confusingly similar or identical to the marks of others that were
 14 distinctive at the time of registration of such domain names, or dilutive of famous marks of
 15 others that were famous at the time of registration of such domain names.

16 **V. CLAIM FOR RELIEF**

17 **FIRST CAUSE OF ACTION**

18 **(Violation of the Anticybersquatting Consumer Protection Act)**

19 17. Plaintiff hereby repeats and re-alleges each and every allegation set forth in
 20 paragraphs 1 through 16, inclusive, as if fully set forth herein.

21 18. By registering and/or using the www.newislandcapital.com domain name,
 22 which is identical to Plaintiff's NEW ISLAND CAPITAL trademark, Registrants have
 23 demonstrated a bad faith intent to profit from Plaintiff's trademark, and have registered,
 24 trafficked in, and used a domain name that is identical or confusingly similar to Plaintiff's
 25 trademark. The Registrants are thus engaging in cyberpiracy in violation of 15 U.S.C. §
 26 1125(d).

19. Upon information and belief, the Registrants have used Plaintiff's trademark as part of the Registrants' domain name with actual knowledge of Plaintiff's trademark, with the intent to cause confusion, and in bad faith. The Registrants' website in fact specifically alludes to Plaintiff as a company in the United that handles assets.

20. Plaintiff's inability to obtain *in personam* jurisdiction over the foreign owner of the www.newislandcapital.com domain name, compels this *in rem* action against the www.newislandcapital.com domain name pursuant to 15 U.S.C. § 1125 (d)(2)(A)(i) and (ii)(I).

21. Plaintiff is damaged by Registrants' continued bad faith intent to profit off of Registrants' use of Plaintiff's NEW ISLAND CAPITAL trademark and the www.newislandcapital.com domain name.

22. Plaintiff has no adequate remedy at law to address the Registrants' cyberpiracy. Plaintiff has been, and absent injunctive relief, will continue to be, irreparably harmed by the Registrants' actions.

23. Plaintiff is entitled to have the Registrants immediately cease using the www.newislandcapital.com domain name and transfer registration of the www.newislandcapital.com domain name (and any other similar domain names) to Plaintiff, pursuant to 15 U.S.C. § 1125(d).

PRAYER FOR RELIEF

WHEREFORE, Plaintiff, New Island Capital Management, Inc., respectfully requests that this Court grant relief under 15 U.S.C. § 1125(d) and 15 U.S.C. § 1117 and:

- (1) enjoin Registrant's use of the www.newislandcapital.com domain name; and
- (2) order the domain registrar eNom, Inc. to transfer the www.newislandcapital.com domain name, to Plaintiff.

Plaintiff further respectfully requests that this Court grant such other and further relief as the Court deems just and proper.

1 Respectfully submitted this 24th day of February, 2012.

2 **FENWICK & WEST LLP**

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4 By: s/ Jeffrey Ware

5 Laurence Pulgram (*pro hac vice application to be filed*)

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